



**UNITED STATES DEPARTMENT OF COMMERCE**  
**Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/393,261      09/10/99      HENSHAW

J      PM-254839

EXAMINER

HM22/0828

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WELLS

ART UNIT

PAPER NUMBER

1619

DATE MAILED:

08/28/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

## Office Action Summary

Application No.

09/393,261

Applicant(s)

HENSHAW, JOSEPH H.

Examiner

Lauren Q Wells

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 14-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☒ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 15. 6) ☐ Other:

### **DETAILED ACTION**

Claims 14-43 are pending in the application. The amendment filed June 19, 2001 added claims 35-43.

#### ***Response to Arguments***

Applicant's arguments with respect to claims 14-34 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Priority***

A certified copy of the PCT application filed on March 21, 1997 is strongly requested. Because of the possible interference, a xerox copy of the published PCT application would not be acceptable.

#### ***Claim Rejections - 35 USC § 112***

Claims 14-43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(i) Claims 17, 26, 31 are still rejected based on their use of tradenames in the claims.

Claim 17, 26 and 31 contain the trademark/trade name DK 446, DK 401, DK 442, DK 512, DK 560, DK 588, DK 591, DK 604, DK 628, DK 634, and DK 512wx. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a

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trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe maize hybrids and, accordingly, the identification/description is indefinite.

(ii) The phrase "material which is an agonist in rodents of cellulosic white core material" is still vague and indefinite, as these phrases are not clearly defined in the specification and one of ordinary skill in the art would not be appraised of them.

(iii) The term "extruded" in claim 39 (line 2) is a relative term which renders the claim indefinite. The term "extruded" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The enormity of the various embodiments of this term renders the claim vague and indefinite.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(c) he has abandoned the invention.

Claims 14-43 are rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention.

Applicant, Henshaw, has submitted a Motion for Preliminary Injunction. In this Injunction, it is disclosed (see pg. 7, 1<sup>st</sup> full paragraph to top of pg. 8), that in 1993 Henshaw's invention was sold to Hudson Feed. "At least as early as 1985, Henshaw conceived of, reduced to practice, and tested a rodenticide that consisted essentially of dried cellulose from crushed corn cobs mixed

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with molasses. . . At least by early 1993, and possibly earlier. . . Henshaw had conceived of the idea of improving his corn cob and molasses rodenticide by formulating it into hard pellets. . . In early 1993, Henshaw, accompanied by Echelbarger, visited Hudson Feeds. . . In early 1993, Hudson Feeds purchased ground cob specifically for Henshaw's product. . . At least by the Summer of 1993, Hudson Feeds produced a pelletized product for Henshaw consisting of crushed corn cobs mixed with molasses. . . in April 1993, Henshaw obtained a certificate to do business under the name of "Delmar Company". . . he adopted the name "Orbis Molasses Pellets" when referring to his product" (see pgs. 6-9).

An impermissible sale has occurred if there was a definite sale, or offer to sell, more than 1 year before the effective filing date of the U.S. application and the subject matter of the sale, or offer to sell, fully anticipated the claimed invention or would have rendered the claimed invention obvious by its addition to the prior art. *Ferag AG v. Quipp, Inc.*, 45 F.3d 1562, 1565, 33USPQ2d 1512, 1514 (Fed. Cir. 1995).

In *Plaff v. Wells Elecs., Inc.*, 119 S.Ct. 304, 311-12, 48 USPQ2d 1641, 1647 (1998) the Supreme Court enunciated a two prong test for determining whether an invention was "on sale". First, the product must be the subject of a commercial offer for sale. . . Second, the invention must be ready for patenting, wherein "ready for patenting" is defined by proof of reduction to practice before the critical date (more than one year before the effective filing date of the U.S. application) or that the inventor had prepared drawings or other descriptions of the invention that were sufficiently specific to enable a person skilled in the art to practice the invention. *Pfaff*, 119 S.Ct. at 311-12, 48 USPQ2d at 1646-47. Per the disclosure of the Injunction, these limitations have been met.

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Claims 14-43 are rejected under 35 U.S.C. 102(c) because the invention has been abandoned.

As stated on pages 7 and 8 of Henshaw's Declaration in the Motion for Preliminary Injunction, it was not until Henshaw learned of Churan's filed United States Patent application that Henshaw pursued a patent, although Henshaw states (pg. 3 of Declaration) that in 1993 Hudson Feeds produced sample R&D batches of his rodent-killing product in pelletized form.

***103 Rejection Maintained***


The rejection of claims 14-34 and newly added claims 35-43 under 35 U.S.C. 103(a) as being unpatentable over Chuhran (6,136,340) is MAINTAINED for the reasons set forth in the Office Action mailed December 19, 2000, Paper No. 11.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diana L Dudash can be reached on (703) 308-2328. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

  
DAMERON L. JONES  
PRIMARY EXAMINER

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lqw

August 10, 2001